

**REMARKS**

The Office Action mailed on 3 December 2002 (hereinafter referred to as the OA) has been received, and its contents carefully studied. The applicant presents this response and amendment which applicant believes is fully responsive to the OA.

The applicant further believes that for the reasons set out below, the currently pending claims are in condition for allowance. Applicant respectfully requests consideration for allowance.

**Claim Rejections**

**Rejections Under 35 USC § 112**

Without prejudice or disclaimer, and fully preserving Applicant's right to re-present the claims or similar material in a child application of this application, pending claims 11-17 have been canceled.

In light of the cancellation of claims 11-17, Applicant respectfully requests any rejections under 35 USC §112 be withdrawn.

Rejections Under 35 USC §102

Claims 1-9, 11-14, 16-17, 21-27, 29-32, 33-34, 38-43, 45-47, and 52-65 are rejected under 35 USC §102 in light of Melen et al., UK Patent Application 2191030 (hereinafter Melen).

Without prejudice or disclaimer, and fully preserving Applicant's right to represent the claims or similar material in a child application of this application, pending claims 1-9, 11-14, 16-17, 26, 29-30, 33, 38-43, 45-47, and 55-57 have been canceled. This leaves claims 21-25, 27, 31, 32, 34, 52-54, and 58-65 pending and rejected under 35 USC §102.

Of the pending rejected claims, claims 21, 52, and 60 are independent claims. The remaining claims rejected under 35 USC §102 depend from these three independent claims (22-25, 27, 31-32, and 34 depend from claim 21; 53-54 and 58-59 depend from claim 52, and 61-65 depend from claim 60). Independent claims 21, 52, and 60 will be discussed first.

Independent claims 21, 52, and 60 have been amended to more clearly claim certain functional aspects of the present invention. It is well established that for claims to be rejected under 35 USC §102, the cite must show both the identical elements and the same interrelationship between the elements as the rejected claim(s). "Under 35 U.S.C. §

102, every limitation of a claim must identically appear in a single prior art reference for it to anticipate the claim.” In re Bond, 910 F.2d, 831, 832, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990). The elements that make up Melen, and the workings of the system as a whole (the relationship between the elements), are not the same as the presently claimed invention, as will be explained. Applicant believes this is true of both the original claims and the currently pending amended claims.

The OA asserts that:

Melen teaches a countdown game (1:30-48): “The aim of the invention is to provide a novel form of game of this general kind but having new features which are particularly attractive to the player. According to the invention, in a gaming or amusement-with-prizes machine of the kind set forth a special awards feature is controlled by a number count which is incremented or decremented progressively and/or at random and decremented or incremented by the amount of a figure which results from the spinning of a reel, the opportunity to spin this further reel being awarded following a non-winning game and giving the chance of a progressive along with award features, for instance along awards “ladders” or “trail” leading to a jackpot, but in the event of the number going beyond a predetermined minimum or maximum the feature is lost.”

The elements in Melen and the claimed invention are not the same. The above quote was given to support the assertion that Melen claims a countdown game. The presently claimed game and the Melen game both have numbers that are used to affect game play (as do most games of chance), but work differently. In particular, please note the role that the counter plays in Melen as compared to the presently claimed invention. In Melen, the state of the counter controls or directs secondary game play (“It is believed that this principle of using a counter, on which the number is incremented and decremented by other factors, to control a feature, the feature being lost when the number oversteps a certain limit, is broadly new” 1:78-83). The “feature” is what the player can win and is

determined by the counter ("According to the invention ... a special awards feature is controlled by a number count which is incremented or decremented ... by the amount of a figure which results from the spinning of a further reel ..." 1:33-40). The counter can be affected by various means discussed in Melen, primarily through the results of a reel that is in addition to the primary game's reels. In the example given in the Melen disclosure, this is a fourth reel where the primary game has three reels. Also, Melen discloses a counter that is a numerical display; that is, a display showing one or two digits ("The two-digit counter 5 may, for instance, comprise a numeric liquid crystal display which can display any number between zero and 99" 1:110-112).

The game of the presently claimed invention has different elements and works differently than Melen. In particular, the only counter that exists in the present invention is the accumulated prize value display. This counter is a "passive" counter; it is to make the current value a prize winnable by a player visible to a player; it does not in any way control or affect game play. Compare this with Melen, where the counter is the control mechanism for the game itself and further where the numbers shown on Melen's counter have no relationship to the prize or award a player can win. The counters are not the same elements, as they have clearly identifiably different functions.

The secondary game event controller (countdown indicator) of the present invention is not a numeric display. Applicant believes this was clear in the original claims; to even more clearly distinguish the game of the present invention the amended

claims show more functional relationship between the countdown indicator and the prize value accumulator, and further characterizes the countdown indicator as having all stop positions visible (no numeric display of the type in Melen can have all its positions, in this case all its numbers between 0 and 99, visible; only one number at a time is visible).

If the Examiner disagrees, Applicant respectfully requests specific cites showing a numerical display in Melen used for the accumulated prize value award amount, so Applicant can respond.

The OA also asserts the following:

Countdown indicator with a plurality of stops (1:49-52): "Preferably, the further reel carries symbols representing numbers, the number count is incremented when normal games are played and decremented by the number represented by the symbol on the further reel which comes to a halt on the win line after each spin of the further reel, the feature being lost when a number count falls below a predetermined minimum, conveniently zero."

This is not describing the countdown indicator of the claimed invention. This is asserting that Melen's number count, displayed in the numerical display discussed in the last paragraph, is the same as Applicant's countdown indicator. For all the reasons discussed in the last paragraph, the number indicator of Melen is not the countdown indicator of the present invention.

Further, the fourth reel is in no way described or used as any type of counter or countdown device in Melen; as such, Applicant notes the cite was for the numerical display as the asserted countdown indicator equivalent and not the fourth reel.

The reel and the numerical panel of Melen are not the same elements as the countdown indicator with a plurality of stops found in the present invention; stipulating that the stop positions are all visible even more clearly distinguishes the claimed invention. In Melen, neither the reel nor the numerical display have all their possible positions visible; some are always hidden. In addition, neither the numerical indicator of Melen nor Melen's fourth reel perform the same function as the countdown indicator of the presently claimed invention. If the Examiner disagrees, Applicant respectfully requests specific cites showing a countdown indicator with a plurality of stop positions where all stop positions visible which indicates a plurality of winning and non-winning secondary game events for a player, so Applicant can respond

The OA further asserts that:

Prize indicator which allows accumulation of prize values (2:33-44): "During the special feature, each time the player spins the fourth reel 4 he advances one step along the award trail 7 to an increased award. However every time the reel 4 is spun, the figure appearing on the win line when it comes to a halt is deducted from the figure appearing on the counter and as soon as that figure goes below a predetermined minimum, zero, the feature is lost altogether and the player loses everything or is warded a minimum consolation prize such as two credits."

This appears to be a misinterpretation of the language. There is nothing in the quote that supports the assertion the prize values are accumulated in Melen. The quoted language (as well as the rest of the Melen disclosure) makes it clear that the numerical display has numerical values added/subtracted to it, and if the numerical either exceeds a certain numerical value or goes below zero, the player loses their ability to collect a prize (the

game ends). In the presently claimed invention, prize values are always increasing until they are won by a player; game play cannot subtract prize values in the present invention. Further and more importantly, the numerical value above is a portion of game play. It is not a prize value, as is the case in the presently claimed invention. The player does not win the amount shown on the numerical display of Melen; rather, the numerical display is used as part of game play, where, if it decreases to 0 or goes above a certain value (presumably 99), the player loses whatever award they might have received. In Melen, there is a set of awards that are the prizes separate from the numerical counter (2:33-44); the prize to be awarded is not represented in any manner by the counter; it is part of the game play to get an award, it is not the award. The counter in the presently claimed invention is completely different, it is the currently value of the prize that a player can win. If the Examiner disagrees, Applicant respectfully requests specific cites showing that the numerical display in Melen is used for an accumulated award amount, so Applicant can respond

The also OA asserts that:

Indicating prize values at random events (2:17-25): "When the special awards feature of the invention becomes available, for example randomly at the end of a non-winning game or on completion of a "fruit-ladders" or "numbers trail", the player is given an opportunity to spin the fourth reel 4 on its own for as many times as he likes with the aim of advancing as far as possible along award trail 7 without losing the feature."

This statement appears to be an error, as Applicant cannot find where in the quote (or in the Melen disclosure anywhere) it discloses that indicating a prize to be added to the accumulated prize of the present invention is based on a random event. The cite given

here describes how the player is enabled or allowed to start the secondary game (Melen's secondary game is started by spinning the fourth reel) as determined by a randomly chosen yes/no event by the gaming machine at the end of primary game play. There is no prize value being indicated in this cite at all. If the Examiner disagrees, Applicant respectfully requests specific cites showing where the prize value in Melen is chosen using a random event, so Applicant can respond

Applicant has shown that elements in Melen, asserted in the OA to be the same as elements in the presently claimed invention as the same are, in fact, not the same. This further shows that the game as whole is different, as the elements interact differently. Further, there are elements having no corresponding element of any kind in Melen (e.g., the prize value accumulator). Applicant has thereby shown that the *prima facie* case of anticipation under 35 USC §102 has not been made. Applicant respectfully requests the rejection of claims 21, 52, and 60 under 35 USC §102 be withdrawn.

As claims 22-25, 27, 31-32, and 34 depend from claim 21, 53-54 and 58-59 depend from claim 52, and, 61-65 depend from claim 60, and each inherits the limitations of its parent independent claim which Applicant has shown has elements not found in Melen, Applicant respectfully requests the rejection of claims 22-25, 27, 31-32, 34, 53-54, 58-59, and 61-65 under 35 USC §102 be withdrawn.

Rejections Under 35 USC §103

The OA rejects claims 10, 15, 28, 32, 44, and 48 under Melen in light of US Patent 5,871,398 to Schneier, et al. ("Schneier").

Claims 10, 15, 44 and 48 have been canceled (see first paragraph). Currently pending claims under this rejection are: 28 and 32. Both claims depend from 21, and add deriving outcomes drawn from a finite pool of outcomes applied to the prize value indicator (28) or the countdown indicator adjuster (32).

Applicant has shown above that independent claim 21 is not anticipated by Melen, having elements not found in Melen and where the game elements do not function as a whole, as in Melen. These elements are further not found in Schneier. Since dependent claims inherit all the elements and limitations of the claims from which they depend, it is the case that claims 28 and 32 are not obvious under Melen in light of Schneier because elements and the game as a whole as claimed have no exact (anticipated) or similar (obvious) components from either Melen or Schneier. If the Examiner disagrees, Applicant respectfully requests specific cites in Melen and Schneier having both all the elements of the presently claimed invention, and the teaching to combine the elements and further showing the inter-relationships between the elements, specifically including but not limited to a countdown indicator having a plurality of visible winning and non-

winning positions and a prize value accumulator coupled in action through a prize value determiner.

Applicant respectfully requests the rejection of claims 28 and 32 under 35 USC §103 be withdrawn.

The OA rejects claims 18-20, 35-37, 49-51, and 66-72 as obvious under Melen in light of Japanese Document 6-91034 to Takemoto et al. ("Tak").

Claims 18-20, 49-51, and 69-72 have been canceled (see first paragraph). Currently pending claims under this rejection are: 35-37 and 66-68. Claims 35-37 depend from claim 21, and claims 67-68 depend from claim 66. Claims 35-37 add the limitation that indicators found in the parent claims form wheel shapes; independent claim 66 includes indicators as wheel shapes. The reference to Tak is for wheel shapes in gaming machines.

As discussed above under the 35 USC §102 response, Melen does not disclose the elements found in independent claim 21. Independent claim 66 includes the same elements discussed for claim 21 that are not found in Melen. Further, Applicant can find no teaching of any kind in either reference to combine the two disclosures to arrive at the presently claimed invention. If Examiner disagrees, Applicant respectfully requests specific cites to each element found in independent claims 21 and 66. As claims 67-68

depend from claim 66 and have, therefore, all of its elements and limitations, the same elements not found in the two references for claim 66 are further not found for claims 67 and 68.

Applicant respectfully requests the rejection of claims 35-37 and 66-68 under 35 USC §103 be withdrawn.

Added Claims 75-86

Newly added claims 75-86 include one added independent claim 75, from which dependent claims 76-86 depend. Independent claim 75 is a means-plus-function claim, including the elements discussed above independent claims 21, 52, and 60. For the same reasons Applicant believes those claims are patentable, Applicant believes claim 75 is patentable (therefore as are its dependents).



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Conclusion

Applicant respectfully submits the currently pending claims are in condition for allowance, and respectfully requests consideration for allowance. Please feel free to contact the undersigned attorney with any questions, suggestions, etc., relative to this application.

Respectfully submitted,

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